

Remarks

In the Final Office Action dated February 26, 2009, claims 1-2, 4-6, 9-12, 14-18, 21 and 24-25 stand rejected under 35 U.S.C. § 103(a) over Hwang (U.S. Patent No. 6,678,511); and claims 3, 13 and 22-23 stand rejected under 35 U.S.C. § 103(a) over the '511 reference in view of Chan (U.S. Patent No. 6,920,471). Applicant traverses all of the rejections and, unless stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant appreciates the withdrawal of the § 112(2) rejection and the response to Applicant's arguments provided in the Final Office Action of February 26, 2009.

Applicant respectfully traverses the rejections under 35 U.S.C. § 103(a) for failing to prove by a preponderance of evidence that the claim limitations are obvious. Applicant requests that the Examiner reconsider the evidence of record to ascertain if it is more likely than not that the claims are patentable under the preponderance of the evidence standard. M.P.E.P. § 706. The evidence put forth by the Examiner is little more than a conclusion that orders of the filters differing by exactly one is an obvious design choice to reach a condition which is "optimum" for some unspecified end goal. For convenience, Applicant reproduces the response of the Examiner below.

Since the second filter of Hwan is use to cancel the ripples within the passband of the filter, the order number of the second filter of Hwang obviously is determined by the number of ripples in the passband of the first filter. Thus, selecting the optimum number for the second filter of Hwang to have the order difference of one as claimed for the purpose of cancelling all of the ripples within the passband of the first filter is considered to be a matter of design expedient for the engineer depending on the ripples of the first filter that would have been obvious at the time of the invention.

The Examiner's logic requires that the skilled artisan impermissibly work backward from Applicant's specification. The Examiner circularly requires that the skilled artisan realize that filters differing in order by exactly one provide the advantageous features taught only by Applicant's specification. Absent Applicant's specification, there is nothing in the record that would suggest to the skilled artisan that filters differing by exactly one would be advantageous. The Examiner's reasoning is applicable to an infinite number of filter combinations because the Examiner's logic has

no reliance upon teachings of the actual order of the filters. If Applicant had discovered that using filters differing in order by twenty or sixty or one million, the Examiner's argument would not change. For example, the evidence of record is the same had the Examiner instead stated that selecting the optimum number for the second filter of Hwang to have the order difference of twenty or thirty or one million for the purpose of cancelling all of the ripples within the passband of the first filter is considered to be a matter of design expedient for the engineer depending on the ripples of the first filter that would have been obvious at the time of the invention. No evidence is provided to suggest how a skilled artisan would work toward reaching the Examiner's conclusion. For the Examiner to maintain the rejection on the evidence provided, the Examiner would have to conclude that an infinite number of filter combinations are obvious in view of only a few concrete filter circuit examples.

It is not permissible to use Applicant's teachings as a basis for the obviousness. Applicant requests that the Examiner reconsider the obviousness of the claim limitations without assuming the skilled artisan would have a reason to know that filters differing in order by exactly one would offer the advantages taught by Applicant's specification.

Applicant again submits that any presumption of obviousness of ranges has been rebutted by the criticality of the claim limitations taught by Applicant's specification. M.P.E.P. § 2144.05.

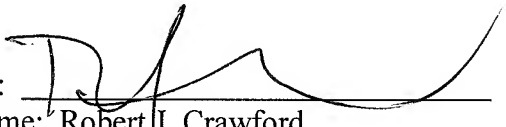
Applicant requests that the Examiner reconsider whether the evidence is more likely than not to show obviousness. Applicant has shown that to maintain the rejection on the basis of the record the Examiner must conclude that it would have been obvious to implement any of an infinite number of different filter orders. The Examiner must further address the criticality of the ranges per M.P.E.P. § 2144.05 and explain how the limited examples presented in the '511 reference render specific and critical ranges obvious. No evidence is presented that would suggest or lead the skilled artisan to the specific, critical ranges. It is Applicant's belief that upon a review of these factors, the Examiner will agree that the preponderance of the evidence weighs in favor of the non-obviousness of the claim limitations. Accordingly, Applicant respectfully requests that the rejections be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Cordeiro, of NXP Corporation at (408) 474-9057 (or the undersigned).

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